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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,771	01/10/2002	Christophe D'Hulst	410.020	7483

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EXAMINER

FOX, DAVID T

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 04/09/2003

124

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/980,771	Applicant(s) D'Hulst et al
Examiner FOX	Group Art Unit 1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Pri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -1- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/12/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disp sition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-19 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

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Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7, drawn to recombinant nucleotide sequences encoding fusion proteins comprising granule-bound starch synthases (including “derivatives” of a particular sequence) and other peptides of interest, and plant cells and plants transformed therewith.

Group II, claim(s) 8-10, drawn to fusion polypeptides comprising granule-bound starch synthases and other peptides of interest.

Group III, claim(s) 11, drawn to isolated starch granules.

Group IV, claim(s) 12-14, drawn to pharmaceutical compositions.

Group V, claim(s) 15, drawn to food compositions.

Group VI, claim(s) 16, drawn to a method of preparing starch granules.

Group VII, claim(s) 17-18, drawn to a method of preparing fusion polypeptides.

Group VIII, claim(s) 19, drawn to a method of biotransformation of starch granules.

The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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The technical feature that links the groups is a nucleotide sequence encoding a fusion protein comprising a granule-bound starch synthase and a second peptide of interest. However, this feature is not special because it does not constitute an advance over the prior art. WO 98/14601 (EXSEED GENETICS) teaches such nucleotides and plant cells and plants transformed therewith (see, e.g., claims 1, 5, 7 and 14-16).

Furthermore, each Group requires physiologically and biochemically divergent starting materials or processes not required by the other. Group I, drawn to a first product and method of its use (transforming plants) requires isolated nucleic acids and plant transformation and regeneration techniques, and isolated living plant cells and plants, each not required by any other group. Group II, a second product, requires isolated polypeptides not required by any other group. Group III, a third product, requires isolated starch granules, not required by any other group. Group IV, a fourth product, requires pharmaceutical adjuvants and agents not required by any other group. Group V, a fifth product, requires food processing reagents and processes not required by any other group. Group VI, a second process, requires methods for starch granule isolation, not required by any other group. Group VII, a third process, requires polypeptide isolation methods, not required by any other group. Group VIII, a fourth process, requires methods for biotransformation of peptides via heat treatment of intact starch granules or other means, not required by any other group.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and fields of search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Furthermore, Applicant is notified that the Preliminary Amendment of 15 November 2001 has not been entered because it did not comply with 37CFR 1.121(c). The marked-up copy of the claims should contain typewritten notations, rather than blue pen notations. Furthermore, material to be deleted should be enclosed in brackets, and material to be added should be underlined.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

April 3, 2003

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180-1638

A handwritten signature in black ink, appearing to read "David T. Fox", written over the printed name and group number.